



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

FRANCZEK *et al.*

Appl. No.: 10/810,443

Filed: March 26, 2004

For: **Computer Virus Screening Methods and Systems**

Confirmation No.: 8971

Art Unit: 2132

Examiner: Almeida, Devin E.

Atty. Docket: 2222.5230005

Arguments to Accompany the Pre-Appeal Brief Request for Review

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit the following Arguments, in five (5) or less total pages, as attachment to the Pre-Appeal Brief Request for Review Form (PTO/SB/33). A Notice of Appeal is concurrently filed.

Arguments

Applicants' arguments in an Amendment and Reply under 37 C.F.R. §1.111 filed on September 24, 2007 (hereinafter "Reply") and an Amendment and Reply under 37 C.F.R. §1.116 filed on January 31, 2008 (hereinafter "Reply to Final") (hereinafter in cumulative referred as prior Replies) were not properly considered or responded to by the Examiner in a final Office Action mailed November 1, 2007 (hereinafter the "Final Office Action") and an Advisory Action mailed February 20, 2008 (hereinafter the "Advisory Action"). In the Final Office Action, claims 1-20 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,623,600 to Ji *et al* (herein "Ji") in view of U.S. Patent No. 5,440,723 to Arnold *et al* (herein "Arnold"). The Examiner's response was legally and factually deficient because the Examiner failed to show that the teachings of Ji and Arnold are sufficient to establish a *prima facie* case of obviousness of claims 1-20.

1. *The Teachings of Ji and Arnold are Insufficient to Establish a Prima Facie Case of Obviousness*

a. *The Combination Cannot be Made for Technical Difficulties as It Would Require Changing a Principle of Operation*

As discussed in Applicants' prior Replies, Ji's device is not properly combinable with Arnold's device to establish a *prima facie* case of obviousness of claims 1-20 due to technical difficulties because to do so would improperly change a principle of operation of Ji's device. Thus, the teachings of Ji and Arnold are insufficient to establish a *prima facie* case.

It is well-settled law that a proposed modification or combination cannot change a principle of operation of a cited reference. According to the M.P.E.P., "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. § 2143.01(VI) (*citing In re Ratti*, 270 F.2d 810 (CCPA 1959)). *See also Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 USPQ 416 (Fed. Cir. 1986) (holding a reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered); 72 Fed. Reg. 57526 (V)(1) (suggesting obviousness cannot be found when "(1) one of ordinary skill in the art could not have combined the claimed elements by known methods (e.g., due to technological difficulties).").

The Applicants' claims 1, 5, and 11 recite features that distinguish over the applied references. For example, claim 1 recites "wherein said screening comprises creating a model of the second computer, installing a program contained in the computer data on the model, and screening the model for the at least one virus," claim 5 recites "a model of the second computer, the model configured to have a program contained in said computer data installed thereon, and wherein said model is further configured to be screened for the at least one

virus," and claim 11 recites "wherein said screening of data comprises creating a model of the first computer, installing on the model a program contained in the data, and screening the model for the at least one virus ." Thus, Applicants' claims include features that are directed towards execution *at an application level*.

As admitted on pages 2-3 in the Final Office Action, Ji's device does not teach this claimed feature. Thus, the Final Office Action attempts to fix this deficiency of Ji by modifying or combining Ji's device with Arnold's device. However, as described in further detail herein, Ji's device is not modifiable or combinable with Arnold's device to establish a *prima facie* case of obviousness of claims 1-20. Ji's device operates by performing *all virus screening below the application level*. Ji explicitly states "[t]he present invention is particularly advantageous because *all virus screening is performed below the application level.*" See, Ji, col. 6, lns. 11-13. (Emphasis added). Thus, performing *all virus screening below the application level* is a principle of operation of Ji's device that is *required* for Ji's device to provide what Ji states is a particularly important advantage of Ji's device.

A principle of operation of Arnold's device includes performing data segregation *at least in part at the application level*. See, Arnold, col. 7 ln. 67 through col. 8, ln. 60. Thus, Arnold performs virus screening *at the application level*. This teaching in Arnold is in direct conflict with the principle of operation of Ji requiring that *all virus screening is performed below the application level* since Arnold performs screening for a virus at least in part *at the application level*. Therefore, modifying or combining Ji's device with Arnold's device would change a principle of operation of either Ji's device, Arnold's device, or both devices. Therefore, Ji's device is neither modifiable nor combinable with Arnold's device, and the

teachings of the references are not sufficient to render the claims *prima facie* obvious. Thus, the Final Office Action fails to establish a *prima facie* case of obviousness.

b. The Combination Cannot be Made Because Ji Teaches Away from the Claims

A *prima facie* case of obviousness is also not established because Ji teaches away from the above-noted distinguishing features in the claims, and what is taught in Arnold. Ji is specifically directed to performing “*all virus screening below the application level.*” See, Ji, col. 6, lns. 11-13. (Emphasis added). However, Applicants’ claims include features that are directed towards execution *at an application level*. Also, Arnold’s device includes performing data segregation *at least in part at the application level*. See, Arnold, col. 7 ln. 67 through col. 8, ln. 60. Thus, since Ji explicitly requires operation *below the application level*, Ji teaches away from performing virus screening at the application level, as recited in the pending claims, and further Ji is not properly combinable with Arnold under binding, relevant Federal Circuit precedent. See *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 USPQ 416 (Fed. Cir. 1986) (holding a reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered); *Gillette Co. v. S.C. Johnson & Sons, Inc.*, 919 F.2d 720, 724, 16 USPQ2d 1923, 1927 (Fed. Cir. 1990) (stating that the closest prior art reference “would likely discourage the art worker from attempting the substitution suggested by [the inventor/patentee].”). Therefore, a *prima facie* case of obviousness is not established because Ji teaches away from performing virus screening *at an application level*.

In the Final Office Action and the Advisory Action, the Examiner asserts that Ji and Arnold are combinable because they suggest to one of ordinary skill in the art that a combination of Ji and Arnold could scan all layers. However, the Final Office Action and the

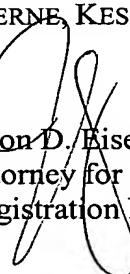
Advisory Action do not address how this can be accomplished without changing the aforementioned principles of operation of both Ji and/or Arnold. Further, the Final Office Action and the Advisory Action do not address the problem of Ji's explicit statement of teaching away from performing virus screening *at an application level*, as recited in the claims. Thus, the Final Office Action and the Advisory Action fail to overcome the Applicants' arguments in the previous Replies, and fail to establish a *prima facie* case of obviousness.

2. Conclusion

Based on the above, Applicants respectfully request that the rejection of claims 1-20 as allegedly being unpatentable over Ji and Arnold be reconsidered and withdrawn. Further, Applicants also respectfully request that all claims be passed to allowance. The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

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Date: 4/30/08

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